

REMARKS

I. Summary of the Office Action

Claims 1-109 are pending in this application.

Claims 110-123 have been withdrawn from further consideration by the Examiner.

Claims 1-6, 8, 10, 11, 14-16, 18, 19, 27-33, 35, 37, 38, 43, 44, 48-49, 57, 60, 62-64, 67, 68, 69, 71, 74, 81, 86, 89-91, 94-96, 99, 100, and 103 are rejected under 35 U.S.C. § 102(b) as being anticipated by Inoue et al. U.S. Patent No. 5,884,141 (hereinafter "Inoue").

Claims 7, 9, 34, 36, 65, and 92 are rejected under 35 U.S.C. § 103(a) as being obvious from Inoue in view of Ismail et al. U.S. Patent No. 6,614,987 (hereinafter "Ismail").

Claims 12, 17, 39, 45-47, 58, 59, 61, 70, 82-85, 87, 88, 97, and 98 are rejected under 35 U.S.C. § 103(a) as being obvious from Inoue in view of Baker et al U.S. Patent No. 5,583,561 (hereinafter "Baker").

Claims 13, 23, 24, 26, 40-42, 53, 54, 56, 66, 77, 78, 80, 93, 106, 107, and 109 are rejected under 35 U.S.C. § 103(a) as being obvious from Inoue in view of Lortz U.S. Patent No. 6,349,410 (hereinafter "Lortz").

Claims 20, 21, 50, 51, 75, and 104 are rejected under 35 U.S.C. § 103(a) as being obvious from Inoue in view

of Banker et al. U.S. Patent No. 5,357,276 (hereinafter "Banker").

Claims 22, 25, 52, 55, 72-73, 76, 79, 101-102, 105, and 108 are rejected under 35 U.S.C. § 103(a) as being obvious from Inoue in view of White et al. U.S. Patent No. 6,392,664 (hereinafter "White").

## II. Summary of Applicants' Reply

Applicants have amended independent claims 57 and 81 to more particularly define the claimed invention. No new matter has been introduced as a result of these amendments. For example, support for the amendments to claims 57 and 81 may be found on page 15, line 9 through page 17, line 7.\*

The Examiner's rejections are respectfully traversed.

## III. Applicants' Reply to the §102 Rejections

Claims 1-6, 8, 10, 11, 14-16, 18, 19, 27-33, 35, 37, 38, 43, 44, 48-49, 57, 60, 62-64, 67, 68, 69, 71, 74, 81, 86, 89-91, 94-96, 99, 100, and 103 are rejected under 35 U.S.C. § 102(b) as being anticipated by Inoue. Applicants respectfully traverse this rejection.

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\* The recitation of support for claims 57 and 81 is not intended to be exclusive. There may be support found elsewhere in the specification.

A. Independent claims 1 and 27

Applicants respectfully submit that, as set forth in detail below, the § 102 rejections are insufficient as a matter of law. The prior art reference does not teach each and every element of the claim. MPEP § 2131. It is not enough for a prior art reference to disclose all the claimed elements in isolation. "The identical invention must be shown [in the prior art] in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.* 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.... *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Applicants respectfully submit that Inoue fails to show or suggest each element as arranged in independent claims 1 and 27. In particular, Inoue fails to show or suggest "retrieving the pause-time content from [a] pause-time content database and playing the retrieved pause-time content while the media is paused." The Examiner relies on two separate and isolated disclosures of Inoue to support the anticipation rejection. (Office Action, page 3, lines 5-9). The first isolated disclosure is found at column 9, lines 31-39, which states:

In an alternate mode of operation, the hard disk 15 is pre-stored with a number of preview clips of programming available from the near video-on-demand signal provider. The user accesses these preview

clips by entering a corresponding command into the user interface 106 which causes microcomputer 109 simply to initiate the reproduction of the data stored on the hard disk. As described above, the preview clips are reproduced and displayed to the user.

This cited disclosure merely indicates that a user may view a preview clip by entering a command on user interface 106. Nowhere in this cited portion, nor in any other portion, does Inoue show or suggest that such preview clips are retrieved and played while media is paused.

The second isolated disclosure is found at column 6, lines 30-33, which states:

During the pause, the video program may continue to be displayed, another program may be received and displayed, or a pause graphics screen may be generated by the microcomputer and displayed.

This cited disclosure merely makes passing reference to a few limited features that may be implemented when a user enters a pause command. However, nothing in this cited portion, nor any other disclosure in Inoue shows or suggests that when the video is paused, preview clips stored on hard drive 15 are retrieved and played.

Applicants respectfully submit that there is no connection between these two separate and isolated portions of Inoue. Yet, despite the apparent disconnect between these two portions of Inoue, the Examiner combines the two isolated portions to support his allegation of anticipation. This is

not permissible. "For a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art ... Although this disclosure requirement presupposes the knowledge of one skilled in the art of the claimed invention, that presumed knowledge does not grant a license to read into the prior art reference teachings that are not there." *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.2d 1461, 43 USPQ2d 1481, 1490 (Fed. Cir. 1997). The pause feature (e.g., cited in column 6), which indicates that a user may pause display of a near video-on-demand program is in no way connected to the preview clips (e.g., cited in column 9), which are disclosed to show that a user may view the preview clips, for example, to determine whether he or she would like to view one or more of the available near video-on-demand programs. Clearly, the Examiner is reading teachings (i.e., that stored preview clips are played during pause) into the reference that are not there.

Accordingly, for at least the reason that Inoue fails to show or suggest either expressly or inherently "retrieving the pause-time content from [a] pause-time content database and playing the retrieved pause-time content while the media is paused," independent claims 1 and 27 are allowable over Inoue. Claims 2-6, 8, 10-11, 14-16, 18-19,

and claims 28-33, 35, 37-38, 43-44, and 48-49 are also allowable for at least the reason they depend from either independent claim 1 or 27. The rejection of these claims should therefore be withdrawn.

B. Independent claims 57 and 81

Applicants' amended independent claims 57 and 81 to specify, among other things, "playing the pause-time content by substituting the pause-time content in place of the media while the media is paused, wherein the subject matter of the substituted pause-time content is related to the subject matter of the paused media." For example, if a user is watching a golf program and pauses the golf program, the played pause-time content is related to the subject matter of the media that is played. In this example, because a golf program is paused, the pause-time content may be an advertisement featuring a new driver or a set of irons. See applicants' specification, page 15, line 25 through page 16, line 8.

The Examiner refers to column 6, lines 30-33 of Inoue to contend that Inoue anticipates independent claims 57 and 81. (Office Action, page 6, lines 3-5).

Inoue states that "the video program may continue to be displayed" during the pause. (Inoue, column 6, lines 30-31). Thus, during pause, the content being

displayed is the same as the video program being displayed prior to pause. There is no "substitut[ion of] pause-time content in place of the media while the media is paused," as specified in independent claims 57 and 81. Accordingly, this portion of Inoue fails to read on applicants' claims 57 and 81.

Inoue also states that "another program may be received and displayed, or a pause graphics screen may be generated by the microcomputer and displayed" during the pause. (Inoue, column 6, lines 31-33). However, there is no showing or suggestion that another program or a pause graphics screen, as disclosed in Inoue, is "pause-time content [having subject matter that] is related to the subject matter of the paused media," as specified in independent claims 57 and 81. Accordingly, this portion of Inoue fails to read on applicants' claims 57 and 81.

Therefore, for at least the reason Inoue fails to show or suggest "playing the pause-time content by substituting the pause-time content in place of the media while the media is paused, wherein the subject matter of the substituted pause-time content is related to the subject matter of the paused media," independent claims 57 and 81 are allowable. Claims 60, 62-64, 67-68, 69, 71, 74, and claims 86, 89-91, 94-96, 99-100, and 103 are also allowable for at

least the reason they depend from either independent claim 57 or 81. The rejection of these claims should therefore be withdrawn.

IV. Applicants' Reply to the 35 U.S.C. § 103 Rejections

Claims 7, 9, 34, 36, 65, and 92 are rejected under 35 U.S.C. § 103(a) as being obvious from Inoue in view of Ismail.

Claims 12, 17, 39, 45-47, 58, 59, 61, 70, 82-85, 87, 88, 97, and 98 are rejected under 35 U.S.C. § 103(a) as being obvious from Inoue in view of Baker.

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Claims 22, 25, 52, 55, 72-73, 76, 79, 101-102, 105, and 108 are rejected under 35 U.S.C. § 103(a) as being obvious from Inoue in view of White.

Applicants have shown above in Section III of this Reply that independent claims 1, 27, 57, and 81 are allowable. The claims listed above, rejected to as being obvious from Inoue in view of a secondary reference, and

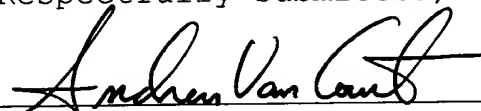


which depend from either independent claim 1, 27, 57, or 81, are allowable at least because they depend from allowable claims. The rejection of these claims should therefore be withdrawn.

V. Conclusion

In view of the foregoing, claims 1-109 are in condition for allowance. This application is therefore in condition for allowance. Reconsideration and allowance of this application are respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Andrew Van Court", is written over a horizontal line.

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